# UNITED STATES DISTRICT COURT DISTRICT OF MINNESOTA

3M COMPANY,

CASE NO. 03-2651 JRT/FLN

Plaintiff,

vs.

INTERTAPE POLYMER GROUP, INC., IPG (U.S.) HOLDINGS INC., IPG (U.S.) INC. and CENTRAL PRODUCTS COMPANY,

Defendants.

DEFENDANT'S EXHIBITS IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

**DEFENDANT'S EXHIBIT NUMBER 19** 

CASE 0:03-cv-02651-JRT-FLN Document 42-5 Filed 05/04/05 Page 2 of 26 PUBLICATION/REGISTRATION REVIEW WORK SHEET Date: 12 Serial No. Olc: All This application was reviewed for publication/registration. information in the database matches all information contained in the file wrapper and no corrections to the database were required. (Signature) INSTRUCTIONS: If information in the data base does not match information in the file wrapper, the reviewer should check (V) the item in Column 2. After correction (text editing), Column 3 should be checked (1). NOTE: RETAIN IN FILE WRAPPER Error Found During Review Requiring Amendment of: Error Edited Screen Code Drawing Code [ Words Mark MK Mark Type: AM Register: Date Register Amended: Amended Register? Prime Classification CL Class Status Date: Inactive Class Status: Active Reclassify ( Delete Add International Class: Reclassiv ( Delete U.S. Class: Add Date of First Use: Date of First Use in Commerce: Prime Class Use in Another Form: AF Goods and Services GS Certification Statement cs Attorney Name | Internal & Street Address [ ] City & State or Country [ ] Zio [ Correspondence: Name [ CD Domestic Representative DR Concurrent Use Statement CU Description of Mark Statement DM 01/00 Disclaimer Lining and Stippling Statement LS Name/Portrait Description/Consent Statement NØ Section 2(f): Entire Mark [ ] In Part [ ] Limitation Statement ( TF Translation of Words in Mark Statement TR Foreign Entry Number: FN Country of Origin: Filing Date: Foreign Application Number: Registration Date: Foreign Registration Number: Foreign Registration Expiration Date: Renewel Date: Foreign Registration Number: Renewed: Foreign Registration Expiration Date: Renewed: Priority Claimed: Section 44(d) Assignment or Name Change NC99 Registration Numbers: Prior U.S. Registrations: PR Applicant: Name PY Entity Statement PY/EN Applicant Entity Type Citizenship Applicant Composed of Statement: CO Doing Business As (DBA) or Also Known As (AKA) Statement: DB Zip Code Applicant: Address: Internal [ ] Street [ ] City [ State/Country PY Other:

All indicated corrections have been entered in the data base in accordance with the above instructions and text editing guidefines.

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CASE 0:03-cv-02651-JRT-FLN Document 42-5, Filed 05/04/05 Page 4 of 26

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#### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Examining Operation

In re application of:

Minnesota Mining and Manufacturing Company, a.k.a., 3M

Serial No. 73/774472

Filed: January 13, 1989

For: Trademark "PREMIUM BLUE"

Trademark Law Office 1 Mary C. Mack Trademark Attorney

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#### **AMENDMENT**

Box 5 Commissioner of Patents and Trademarks Washington, D.C. 20231

Dear Sir/Madam:

In response to the Office Action mailed September 26, 1989, please amend the above application to the Supplemental Register by deleting the word "PRINCIPAL" and substitute therefore the word -- "SUPPLEMENTAL"--.

Additionally, please amend the application to contain the statement that: - Applicant has used the mark lawfully in interstate commerce with the goods for the year preceding the filing date of this Amendment to the Supplemental Register--.

CASE 0:03-cv-0265 - JRT-FLN Document 42-5 Filed 05/04/05 Page 6 of 26

#### REMARKS

The above Amendment is made in response to the Office Action mailed September 26, 1989. It is believed that, after this Amendment has been entered, this application will be found to be in condition to be issued, and such action is earnestly solicited.

Respectfully submitted,

C. H. Lauder

Attorney for Applicant

November 7, 1989 P.O. Box 33427 St. Paul, Minnesota 55133-3427 (612) 733-1510 CASE 0:03-cy-02651-JRT-FLN Document 42-5 Filed 05/04/05 Page 7 of 26 U.S. DEPARTMENT OF COMMERCE - Patent and Trademark Office

IN REPLY REFER TO THE FOLLOWING AND THE FILING DATE:

Paper No.

"Box 5."

**APPLICANT** SERIAL NO. ADDRESS: 73/774472 MINNESOTA MINING AND MANUFACTURING COMPACT Commissioner of Patents and MARK Trademarks Washington, DC PREMIUM BLUE ACTION NO. 20231 ADDRESS MAILING DATE all correspondence 02 CHARLES H. LAUDER 3M CENTER 09/26/89 not containing fee payments should SAINT PAUL, MN 55144 include the word

FORM PTO-1525 (2-84)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

Also furnish: (1) Serial number of application, (2) The mark, (3) Examining Attorney's name and Law Office number, (4) Mailing date of this action, and (5) Applicant's name (or applicant's attorney), telephone number and zip code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

774472 9/21

This letter responds to Applicant's communication filed on August 28, 1989.

Applicant's amendment to the identification and classification have been entered in the record. The refusal under Section 2(e)(1) of the Trademark Act is repeated and hereby made FINAL on the ground that the proposed mark merely describes a feature or characteristic of applicant's goods.

Applicant's goods are masking tape of premium grade and blue in color. As a result, the mark merely describes under Section 2 of the Act a feature or characteristic of the goods.

The Trademark Act Section 23, 15 U.S.C. Section 1091, requires that an Applicant complete one year of lawful use before seeking registration on the Supplemental Register. The Applicant does not satisfy this requirement at this time. The Applicant will be eligible for registration on November 5, 1989, and on or after this date can amend the application by submitting the following statement:

The Applicant has used the mark lawfully in interstate commerce with the goods for the year preceding the filing date of this amendment to the Supplemental Register.

Page 2

37 C.F.R. Section 2.47; TMEP sections 1115.01 and 1115.02. The Applicant must indicate the type of commerce, for instance, interstate.

In addition, please note that the Trademark Law Revision Act of 1988, which takes effect on November 16, 1989, will eliminate the requirement that the Applicant use the mark in commerce for one year to seek registration on the Supplemental Register. Therefore, an amendment to seek registration on the Supplemental Register which is filed on or after that date does not require the "one-year-lawful-use" statement.

MCM/lr

Mary C. Mack
Trademark Attorney
Law Office 1
(703) 557-3273
Serial No. 774472

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THE UNITED STATES PATENT AND TRADEMARK OFFICE Trademark Examining Operation

In re application of:

Minnesota Mining and Manufacturing Company, a.k.a., 3M

Serial No. 73/774472 \_\_\_

Filed: January 13, 1989

For: The Trademark "PREMIUM BLUE" -

Trademark Law Office 1

Mary Mack Trademark Attorney

AMENDMENT

Box 5 Commissioner of Patents and Trademarks Washington, D.C. 20231 .

Dear Sir/Madam:

In response to the Office Action mailed March 10, 1989, please amend the identification of goods in the above application by deleting therefrom the words "adhesive tape," and substitute therefor the words -- masking tape --.

Additionally, please amend the class number of this application by deleting therefrom the number "16," and substitute therefor the number -- 17 ---.

#### REMARKS

The above amendment is made in response to the request for clarification of the identification of goods contained in the Office Action mailed March 10, 1989.

In response to the request contained in that Office Action, the Applicant submits herewith a photograph of the goods.

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TDMK 000035

As can be seen from the enclosed photograph, the masking tape sold under this trademark is blue in color, but Applicant is not claiming the color blue as part of its trademark. Instead, Applicant's trademark is "PREMIUM BLUE", and it is submitted that the words representing colors for many goods have been included as part of the trademarks for them. Accordingly, Applicant requests reconsideration of the rejection under Section 2(e)(1), and it is believed that, upon such reconsideration, after entry of the above amendment, this application will be found to be in condition to be passed to publication, and such action is earnestly solicited.

Respectfully submitted,

C. H. Lauder

Attorney for Applicant

August 7, 1989 P.O. Box 33427 St. Paul, Minnesota 55133-3427 (612) 733-1510 CASE 0:03-cv-02651-JRT-PLN Document 42-5 Filed 05/04/05

U.S. DEPARTMENT OF COMMERCE - Patent and Trademark Office

IN REPLY REFER TO THE FOLLOWING AND THE FILING DATE:

APPLICANT 73/774472 MINNESOTA MINING AND MANUFACTURING COMPAET SERIAL NO.

Paper No.

MARK

PREMTUM BLUE

ADDRESS

CHARLES H. LAUDER 3M CENTER SAINT PAUL, MN

ACTION NO. 01

MAILING DATE

03/10/89

ADDRESS: Commissioner of Patents and Trademarks Washington, DC 20231

The address of all correspondence not containing fee payments should include the word "Box 5."

FORM PTO-1525 (2-84)

U.S. DEPT. OF COMM. PAT. & TM OFFICE

Also furnish: (1) Serial number of application, (2) The mark, (3) Examining Attorney's name and Law Office number, (4) Mailing date of this action, and (5) Applicant's name (or applicant's attorney), telephone number and zip code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

774472

The assigned Examining Attorney has reviewed the referenced application and determined the following.

The Examining Attorney refuses registration on the Principal Register because the proposed mark merely describes the goods. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1) (1986); TMEP section 1209.01.

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1) (1986), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) •

Applicant's goods are a premium grade blue tape and, as such, the proposed mark merely describes a feature or characteristic of the goods.

The Applicant must submit photograph or sample of the goods to permit proper consideration of the application. 37 C.F.R. Section 2.61(b); TMEP sections 1103.04 and 1105.02.

The identification of goods is indefinite. It appears from the specimens of record that applicant's goods are masking tape. If accurate, amendment to classification is necessary. The following is suggested:

masking tape in class 17.

The Examining Attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) (1986). TMEP section 1105.01.

MM:ics

-7272-377

Mary Mack C. March

Trademark Attorney, Law Office 1

703 557-4655

CASE 0:03-cv-02651-JRF-FLN Document 42/5/ Hile 1/04/05 Page 14/of 26

73/774472

ADEMARK APPLICATION,

Supplymental PRINCIPAL REGISTER, WITH DECLARATION (CORPORATION)

MARK: PREMIUM\_BLUE CLASS NO. 16 / /

Ed DB (03) TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

Minnesota Mining and Manufacturing Company, a.k.a. 3M, a corporation of the State of Delaware, 3M Center, Saint Paul, Minnesota 55144.

PERTINATION ON

The above identified applicant has adopted and is using the trademark shown in the accompanying drawing for the following goods: Adhesive tape and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946.

The trademark was first used on the goods at least as early as November 5, 1988; was first used on the goods in interstate commerce at least as early as November 5, 1988; and is now in use in such commerce.

The mark is used by applying it to labels affixed to the containers for the goods and five specimens showing the mark as actually used are presented herewith.

Walter N. Kirn being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that he is Assistant . Secretary of applicant corporation and is authorized to execute this instrument on behalf of said corporation; he believes said corporation to be the owner of the trademark sought to be registered; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that facts set forth in this application are true; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

MINNESOTA MINING AND MANUFACTURING COMPANY

By:

Walter N. Kirn

Assistant Secretary

CASE 0:03-cv-02651 JRT-FLN Document 42-5 Filed 0: 04/05 Page 15 of 26

#### POWER OF ATTORNEY

Minnesota Mining and Manufacturing Company, a.k.a. 3M, hereby appoints/Charles H. Lauder, 3M Center, Saint Paul, Minnesota 55144/phone 612-733-1510, an attorney admitted to practice before the Supreme Court of the State of Minnesota, as its attorney, with full power of substitution and revocation, to prosecute this application to registration, to receive the certificate of registration when issued, and to transact all business with the Patent and Trademark Office in connection therewith.

PRI

MINNESOTA MINING AND MANUFACTURING COMPANY

Walter N. Kirn

Assistant Secretary

TRADEMARK APPLICATION SERIAL NO. 73/774472

U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE FEE RECORD SHEET

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 $\textbf{Scotch}^{\textbf{TM}}_{\textbf{Brand}}$ 

Premium Blue™ Painters' Tape

3/4 In x 40 Yds (19.0mm x 36.5m)

12 Rolls

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Scotch Brand

Premium Blue™ Painters! Tape

3/4 In x 40 Yds (19.0mm x 36.5m)

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12 Rolls

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Premium Blue™ Painters' Tape

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Int. Cl.: 17

Prior U.S. Cl.: 5

Reg. No. 1,582,068

United States Patent and Trademark Office

Registered Feb. 6, 1990

### TRADEMARK SUPPLEMENTAL REGISTER

## PREMIUM BLUE

MINNESOTA MINING AND MANUFACTUR-ING COMPANY (DELAWARE CORPORA-TION), AKA 3M, 3M CENTER SAINT PAUL, MN 55144

FOR: MASKING TAPE, IN CLASS 17 (U.S. CL. 5).

FIRST USE 11-5-1988; IN COMMERCE 11-5-1988.

SER. NO. 73-774,472, FILED P.R. 1-13-1989; AM. S.R. 11-13-1989.

MARY C. MACK, EXAMINING ATTORNEY

13/774472

Applicant:

Minnesota Mining and Manufacturing

Company, a.k.a. 3M, a corporation of the

State of Delaware

Address:

3M Center, Saint Paul, Minnesota 55144

Date of First Use:

At least as early as November 5, 1988

Date of First Use

In Interstate

Commerce:

At least as early as November 5, 1988

Goods:

Adhesive tape

1-13-89

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PREMIUM BLUE

AMENDED TO 7 SUPPLEMENTAL REGISTER

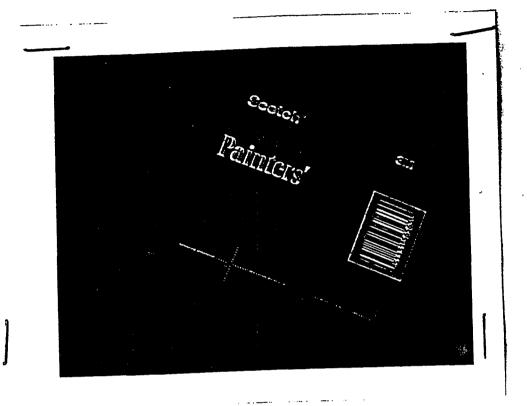
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